UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,551	07/06/2001	Alicia Anne Chastain	RSW920010058US1	5014

36736 7590 08/17/2004	EXAMINER
DUKE W. YEE	LY, ANH

	ART UNIT	PAPER NUMBER
YEE & ASSOCIATES, P.C.	2172	
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DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 16-27* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 16-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This Office action is response to Application's Appeal Brief filed on 06/14/2004.

2.   Claims 1-14 and 16-27 are pending in this application.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.   Claims 1-12, 13, 23, 24 and 26-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent No. 6,714,214 issued to DeMello et al. (herein after

DeMello) in view of US Patent No. 6,192,396 issued to Kohler.

With respect to claim 1, DeMollo teaches receiving a user input selecting the text

from the electronic book to form selected text (a user enables to receive input text from

electronic book such as notebook computers, personal digital assistants (PDAs) or

handheld devices: col. 4, lines 22-25 and col. 5, lines 45-60; also see col. 1, lines 35-40

and col. 2, lines 10-15, and to form a selected text from the input text by highlighting the

desired word(s) or text or passage or notation or portion of document: see figs 3A-3B

with functions from the pop-up menu such as highlight: col. 6, lines 25-67 and col. 7,

lines20-48).

DeMello teaches data processing under e-book environment from which users

enable to create a selected text from an input text or document displayed in the

handheld or PDA or notebook or mobile or portable devices and distribute or transmit or

transfer the selected text to different users under distributing computing environment.

DeMello does not clearly teach automatically sending the selected text to each

electronic book for a designated set of recipients in response to receiving the user input

selecting the text.

However, Kohler teaches for each recipient, at least one portion of the message

is associated with recipient, such that at least one recipient does not receive all portions

of the message (1, lines 60-65, col. 2, lines 30-40; also see abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of DeMello with the teachings of Kohler by incorporating the use of sending portion of message to each recipient in the list recipients such that at least one recipient does not receive all portions of the message. The motivation being to have allowed the use of the highlight function to select the text, identifying the recipients from list of recipients and sending the portion or portions of message to each recipient who receives only its designated portion or portions of selected text or message.

With respect to claims 2-4, Demello teaches a method as discussed in claim 1.

DeMello teaches data processing under e-book environment from which users enable to create a selected text from an input text or document displayed in the handheld or PDA or notebook or mobile or portable devices and distribute or transmit or transfer the selected text to different users under distributing computing environment. DeMello does not clearly teach displaying a list wherein the designated set of recipients is selected from the list, the selected is highlighted text and wherein the highlighted text in a different color from unselected, bolded text, and text with a different font type from unselected text. .

However, Kohler teaches a list of intended recipients is displayed (see fig. 7 and col. 6, lines 65-67), using focus indicator to highlight the selected text (col. 6, lines 28-30) and using color to differ with the unselected text (col. 6, lines 32-36).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of DeMello with the

teachings of Kohler by incorporating the use of displaying a list of intended recipients for user or sender to select in order to send portion of message to each recipient in the list recipients such that at least one recipient does not receive all portions of the message. The motivation being to have allowed the use of the highlight function to select the text, identifying the recipients from list of recipients and sending the portion or portions of message to each recipient who receives only its designated portion or portions of selected text or message.

With respect to claim 5, DeMello teaches storing the highlighted text in a data structure (see figs 6A and 6B, col. 9, lines 45-58).

With respect to claim 6, DeMello teaches wherein the data structure is a download file (text annotation is downloaded and/or uploaded to handheld devices: col. 5, lines 50-55).

With respect to claim 7, DeMello teaches wherein the text is a notated message of text in the electronic book (the selected text is in the PDA or notebook or handheld device: col. 6, lines 26-37).

With respect to claim 8, DeMello teaches wherein the text is a highlighted passage of text in the electronic book (the highlighted object of an input text displayed in the PDA: col. 6, lines 32-37).

With respect to claims 9-12, Demello teaches a method as discussed in claim 1.

DeMello teaches data processing under e-book environment from which users enable to create a selected text from an input text or document displayed in the handheld or PDA or notebook or mobile or portable devices and distribute or transmit or

transfer the selected text to different users under distributing computing environment. DeMello does not clearly teach wherein the sending step sends the highlighted text to the designated set of recipients using a communications link, in an electronic message, wherein the highlighted text is located in a body of the electronic mail message and in an attachment attached to the electronic mail message.

However, Kohler teaches email message is transferred over network (see fig. 1 col. 3, lines 50-63), computerized messages such as e-mail (col. 1, lines 48-51), the highlighted text is located in a body of the e-mail message 9col. 9, lines 65-67 and col. 10, lines 1-16), and an attachment attached in an e-mail message (col. 5, lines 60-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of DeMello with the teachings of Kohler by incorporating the use of displaying a list of intended recipients for user or sender to select in order to send portion of message to each recipient in the list recipients such that at least one recipient does not receive all portions of the message. The motivation being to have allowed the use of the highlight function to select the text, identifying the recipients from list of recipients and sending the portion or portions of message to each recipient who receives only its designated portion or portions of selected text or message.

With respect to claim 13, DeMollo teaches receiving a first user input selecting the text from the electronic book (a user enables to receive input text from electronic book such as notebook computers, personal digital assistants (PDAs) or handheld devices: col. 4, lines 22-25 and col. 5, lines 45-60; also see col. 1, lines 35-40 and col.

2, lines 10-15, and to form a selected text from the input text by highlighting the desired

word(s) or text or passage or notation or portion of document: see figs 3A-3B with

functions from the pop-up menu such as highlight: col. 6, lines 25-67 and col. 7, lines

20-48).

DeMello teaches data processing under e-book environment from which users

enable to create a selected text from an input text or document displayed in the

handheld or PDA or notebook or mobile or portable devices and distribute or transmit or

transfer the selected text to different users under distributing computing environment

and the users enable to select a number of annotation feature. DeMello does not

clearly teach displaying a list of recipients, receiving a second user input selecting a

designated set of recipient from the list of recipients, and sending the highlighted text to

each electronic book for a designated set of recipients.

However, Kohler teaches a list of intended recipients is displayed (see fig. 7 and

col. 6, lines 65-67), for each recipient, at least one portion of the message is associated

with recipient, such that at least one recipient does not receive all portions of the

message (1, lines 60-65, col. 2, lines 30-40; also see abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to combine the teachings of DeMello with the

teachings of Kohler by incorporating the use of sending portion of message to each

recipient in the list recipients such that at least one recipient does not receive all

portions of the message. The motivation being to have allowed the use of the highlight

function to select the text, identifying the recipients from list of recipients and sending

the portion or portions of message to each recipient who receives only its designated portion or portions of selected text or message.

Claim 23 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 24 is essentially the same as claim 13 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 13 hereinabove.

Claim 26 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 27 is essentially the same as claim 1 except that it is directed to a computer program product in a computer readable medium rather than a method, and is rejected

6.   Claims 14, 16-17, 18-19, 20-22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,714,214 issued to DeMello et al. (herein after DeMello) in view of US Patent No.6, 396,513 issued to Helfman et al. (hereinafter Helfman).

With respect to claim 14, DeMello teaches receiving selected text from at least one electronic book through a communications link to the data processing system (a user enables to receive input text from electronic book such as notebook computers, personal digital assistants (PDAs) or handheld devices: col. 4, lines 22-25 and col. 5, lines 45-60; also see col. 1, lines 35-40 and col. 2, lines 10-15, and to form a selected text from the input text by highlighting the desired word(s) or text or passage or notation or portion of document: see figs 3A-3B with functions from the pop-up menu such as highlight: col. 6, lines 25-67 and col. 7, lines 20-48).

DeMello teaches data processing under e-book environment from which users enable to create a selected text from an input text or document displayed in the handheld or PDA or notebook or mobile or portable devices and distribute or transmit or transfer the selected text to different users under distributing computing environment and the users enable to select a number of annotation feature. DeMello does not clearly teach sorting the selected text, displaying the sorted text and responsive to a user input selecting at least a portion of the sorted text being displayed.

However, Helfman teaches automatically sorting the selected into mailboxes based on the criteria defined by user (see abstract, col. 3, lines 1-25) and displaying the sorted the selected message (col. 4, lines 12-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of DeMello with the teachings of Helfman by incorporating the use of sorting the message based on the criteria and displaying the sorted text to user from which the user would be identified

which message to be view based on the prioritizing and ranking of the mailbox. The

motivation being to have allowed the use of the prioritizing and ranking message from

which the message is highlighted/selected via highlight function, identifying the

recipients from list of recipients and sending the portion or portions of message to each

recipient who receives only its designated portion or portions of selected text or

message.

With respect to claims 16-17 and 20-22, DeMello teaches a method as discussed

in claim 14.

DeMello teaches data processing under e-book environment from which users

enable to create a selected text from an input text or document displayed in the

handheld or PDA or notebook or mobile or portable devices and distribute or transmit or

transfer the selected text to different users under distributing computing environment

and the users enable to select a number of annotation feature. DeMello does not

clearly teach selection criteria is used to sort and group the selected text and includes at

least one of popularity name of a user originating text, selection criteria.

However, Helfman teaches prioritizing and ranking the message based on the

criteria of the mailboxes and the name of a user originating text (col. 3, lines 55-65 and

col. 4, lines 1-58).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to combine the teachings of DeMello with the

teachings of Helfman by incorporating the use of sorting the message based on the

criteria and displaying the sorted text to user from which the user would be identified

which message to be view based on the prioritizing and ranking of the mailbox. The

motivation being to have allowed the use of the prioritizing and ranking message from

which the message is highlighted/selected via highlight function, identifying the

recipients from list of recipients and sending the portion or portions of message to each

recipient who receives only its designated portion or portions of selected text or

message.

With respect to claims 18-19, Demello teaches remote electronic book (col. 5,

lines 45-60 and annotation made by a user (col. 1, lines 35-40).

Claim 25 is essentially the same as claim 14 except that it is directed to a data

processing system rather than a method, and is rejected for the same reason as applied

to the claim 14 hereinabove.

Contact Information

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is 703 306-4527 or via E-Mail: ANH.LY@USPTO.GOV. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on 703 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703 746-7239.

Any response to this action should be mailed to:
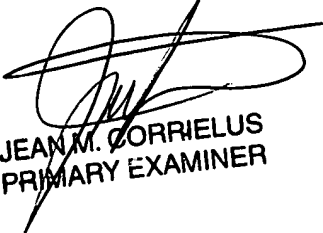
Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: Central Fax Center (703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-6606 or 703 305-3900.

ANH LY
AUG. 11th, 2004

JEAN M. CORRIELUS
PRIMARY EXAMINER